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46322 7590 03/31/2009 CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP STEVEN M. GREENBERG 950 PENINSULA CORPORATE CIRCLE SUITE 3020 BOCA RATON, FL 33487				
EXAMINER WOZNIAK, JAMES S				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/730,540

Applicant(s)

AGAPI ET AL.

Examiner

JAMES S. WOZNIAK

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. In response to the office action from 10/10/2008, the applicant has submitted an amendment, filed 1/11/2009, while arguing to traverse the art rejection based on the limitation regarding an audio recordation plan comprising planned audio segments and corresponding file names (*Amendment, Pages 16-18*). Applicant's arguments have been fully considered, however the previous rejection is maintained due to the reasons listed below in the response to arguments.

Response to Arguments

2. Applicant's arguments have been fully considered but they are not persuasive for the following reasons:

With respect to the previous 35 U.S.C. 112, Second Paragraph rejection, the applicants argue that the language of claims 1, 11, and 21, which includes "files names of recorded audio file," "could not be more clear as to what is required for the recordation plan" (*Amendment, Pages 14-15*). In response, the examiner notes that it is not what elements comprise a recordation plan that renders the claim indefinite, as has been argued by the applicant, but the limitation regarding the file names. The file names, which are part of a recordation *plan*, in the claims are recited as being "corresponding file names of *recorded* audio files of the *planned* audio segments". This limitation lacks clarity, and thus, renders the claim indefinite because it is

contradictory and unclear. In one instance, the claim states that it generates a recordation “plan” for “*planned* audio segments”, but then additionally sets forth that the plan includes “file names of *recorded* audio files” (*note the past tense- recorded*). If the generated list is for planned audio segments as it sets forth, it is unclear how it contains file names of *recorded* audio files (*i.e., files that have been already recorded*). Rather, as was pointed out in the previous Office Action (*Page 4*), it would appear that the file names included in the recordation plan should correspond to file names *to be used* for recorded audio files once they have been recorded according to the generated plan instead of file names for recorded audio files. Since the claims lack clarity for at least the above reasons, they do not comply with the requirement for definiteness. Thus, these arguments have been fully considered, but are not convincing.

With respect to a further aspect of the previous 35 U.S.C. 112, Second Paragraph rejection, the applicants argue that examiner provides no evidence that one of ordinary skill in the art would not recognize a computer having a CPU that performs a process would not inherently include a memory for program storage and notes that the applicants are not aware of a situation where a computer contains a CPU that would not have a memory with instructions (*Amendment, Pages 14-15*). In response, the examiner notes that the issue raised in this 35 U.S.C. 112, Second Paragraph rejection is the lack of an essential element in the claim. The fact that the applicants have recognized the necessity of a memory storing a program for processor operation further supports this position (*see also Specification, Paragraph 0045, which notes the requirement of a stored program on a medium for execution by a processor so that the method can be performed*). In Claim 21, a processor would not be capable of performing its associated functions if it did not access a program stored in memory, thus the omission of this element

necessitates the 35 U.S.C. 112, Second Paragraph rejection. Therefore, these arguments have been fully considered, but are not convincing.

Turning now to the art rejections, the applicants argue that the examiner has misinterpreted the applicants' arguments because the applicants allege that their claimed invention requires a recordation plan that includes "(1) a file of planned audio segments (2) file names of recorded audio files (3) the recorded audio files correspond[ing] to the planned audio segments" (*Amendment, Pages 16-17*).

In response, the examiner first notes that the claim defines the audio recordation plan as comprising "a file of planned audio segments and corresponding file names of recorded audio files of the planned audio segments". Nowhere in the claim is there any mention of "(3) the recorded audio files corresponding to the planned audio segments" (*Amendment, Page 17*). In fact, nowhere in the specification is there any description of a recordation plan comprising "recorded audio files". Figure 4, for example, shows the applicants "audio recordation plan". The plan is simply a spreadsheet file featuring a column of text that will be used in an interactive voice application that needs to be read by a voice professional to create an audio file for the application and another associated column of text containing file names that will be assigned to the recordings created by the professional. These are simply file names, however, the recorded files themselves have not and will not be created until the left hand column is read by the professional ("*The result is a file recordation plan in the form of a record of files that can be easily used by a voice professional to quickly and efficiently produce recorded audio segments (using the required file names) that will be used in the interactive voice response application*", *Specification, Paragraph 0021*; "*Fig. 2 representing a recordation plan with planned audio*

segments," Specification, Page 10; "needs to be recorded," Specification, Paragraph 0025; "By examining the file listing in Fig. 2, the voice professional can quickly determine the audio text that needs to be recorded for a specific voice application, Specification, Page 13; and "the planned audio segment and its associated file name is written to an output file," Specification, Paragraph 0030). This plan structure is what is represented in the independent claims- a file (*i.e., file such as a spreadsheet*) of planned audio segments (*i.e., text to be read by a professional to create the audio segments from the left-hand column*) and corresponding file names of recorded audio files of the planned audio segments (*i.e., listed file names such as intro.au, main.au, but not the actual recorded audio files*). Therefore, there is no mention in the claims or even the specification that a recordation plan comprises "(3) the recorded audio files corresponding to the planned audio segments". In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (*i.e., a recordation plan comprises "(3) the recorded audio files corresponding to the planned audio segments"*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The applicants continue their arguments by pointing to the examiner's alleged continuing comparison between the claim language and the VoiceXML script portions and recorded audio file corresponding to the text in Busayapongchai et al (*U.S. PG Publication: 2004/0254792*), which they allege does not meet their claimed invention. Specifically, the applicants argue that Busayapongchai does not teach an audio recordation plan that includes a file of planned audio

segments, each with a corresponding file name of a recorded audio file that corresponds to one of the planned audio segments because Busayapongchai's file is VoiceXML script that does not list file name for recorded audio that corresponds to an audio segment also listed in the file (*Amendments, Pages 17-18*). In response, the examiner points out that, as was noted above, neither the claims nor the specification disclose that an actual recorded audio file is part of an audio recording plan. The claims only require that a recording plan is a file that comprises planned audio segments each with a corresponding file name for the audio file once it is recorded. Busayapongchai teaches this claim limitation. Specifically, Busayapongchai recites that audio text to be recorded as voice prompts in a voice application and their associated extracted properties from a VoiceXML script are extracted and passed to a recording process (*Paragraph 0031*). These text and properties, which are extracted and forwarded, make up the file are used by the recording manager in automatically populating an audio file name in a VoiceXML script, and thus, also include the file name (*Paragraphs 0036 and 0039*). In this way, the data file extracted from the VoiceXML extraction and passed to a recording professional includes the audio text to be recorded and file name information as is recited in the independent claims. Thus, these arguments have been fully considered, but are not convincing.

The art rejection of the further dependent claims is traversed for reasons similar to the independent claims. In regards to such arguments, see the above response directed towards the independent claims.

Claims 1-10 have been re-analyzed under the most current 35 U.S.C. 101 guidance and found to be directed to non-statutory subject matter. These new rejections have been included below.

Claim Objections

3. **Claims 21-29** are objected to because of the following informalities:

Claim 21 recites a "computer *having* a central processing unit". Since the computer only *has* this CPU, it is not clear as to whether it is actually part of the computer (i.e., it is not positively recited in the claim). It is recommended to change "having" to --comprising-- in order to overcome this objection. Dependent claims 22-29 fail to overcome this objection, and thus, are also objected to by virtue of their dependency.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 1-10** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim(s) 1 and associated dependent claims 2-10 is/are rejected under 35 USC 101 as not falling within one of the four statutory categories of invention. While the claim(s) recite a series of steps or acts to be performed, a statutory "process" under 35 USC 101 must (1) be tied to another statutory category (such as a manufacture or a machine), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. The instant claim(s) neither transform underlying subject matter (*i.e., no physical transformation occurs only the*

manipulation of data) nor positively recite structure associated with another statutory category (*i.e., the claim does not rely on any type of physical hardware and a human being would be capable of looking through VoiceXML script, determining the parts of the script associated with future audio prompts, and manually create a list of these prompts*), and therefore do not define a statutory process.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 1-29** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1, 11, and 21 specify that a recordation plan for audio segments to be recorded by a voice professional comprises "file names of recorded audio files of the planned audio segments", however, it is uncertain how audio files that have not yet been recorded can be considered to have "file names of *recorded* audio files". It is assumed that the file names correspond to those *to be used* when the audio text has been spoken and recorded. As such, claims 1, 11, and 21 will be interpreted accordingly for the sake of advancing prosecution. The further dependent claims fail to overcome this issue, and thus, are also rejected for being indefinite.

8. **Claims 21-29** are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: a memory storing a computer program that the central processing unit of the computer executes to perform the claimed functions (*see specification, Paragraph 0045*). Without the execution of the program taken from the memory, the CPU would not be able to perform its recited functions. The further dependent claims fail to overcome this issue, and thus, are also rejected under similar rationale.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. **Claims 1, 10-11, and 20-21** are rejected under 35 U.S.C. 102(e) as being anticipated by Busayapongchai et al (*U.S. PG Publication: 2004/0254792*).

With respect to **Claim 1**, Busayapongchai discloses:

Identifying planned audio segments in the speech application program, the audio segments containing audio text to be recorded and associated file names (*identifying audio text in a VoiceXML script, referencing recordable text and associated file naming descriptors, Paragraphs 0028-0030*);

Extracting the audio segments from the speech application program (*parser extracting text strings from VoiceXML scripts, Paragraph 0031*); and

Processing the extracted audio segments to create an audio text recordation plan comprising a file of planned audio segments and corresponding file names of recorded audio files of the planned audio segment (*recording manager that passes extracted text strings to a voice talent for manual recording, wherein the information includes file name information Paragraphs 0031 and 0036-0039*).

With respect to **Claim 10**, Busayapongchai discloses the VoiceXML script as applied to Claim 1.

With respect to **Claim 11**, Busayapongchai discloses the method, as applied to claim 1, implemented as a program stored on a computer readable medium (*Paragraphs 0023-0026*).

Claim 20 contains subject matter similar to Claim 10, and thus, is rejected under similar rationale.

With respect to **Claim 21**, Busayapongchai discloses the method, as applied to claim 1, implemented in a computer's CPU (*Paragraphs 0023-0026*).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 2-5, 12-15, and 22-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Busayapongchai et al in view of Ladd et al (*U.S. Patent: 6,269,336*).

With respect to **Claim 2**, Busayapongchai discloses the method for extracting and producing audio text for recording as applied to Claim 1. Busayapongchai does not specifically suggest identifying text associated with a pause, creating a silence file associated with the identified pause, and modifying an audio file referenced by the text containing the pause information. Ladd, however, recites the ability to process a “break” element in VoiceXML script to divide audio text scripts, insert a predefined length of audio silence, and divide audio prompts (*Col. 29, Line 58- Col. 30, Line 26*).

Busayapongchai and Ladd are analogous art because they are from a similar field of endeavor in VoiceXML processing systems. Thus, it would have been obvious to a person of ordinary skill in the art, at the time of invention, to modify the teachings of Busayapongchai with the break element taught by Ladd in order to configure and add natural speaking characteristics to a VoiceXML page (*Ladd, Col. 16, Lines 11-20*).

With respect to **Claim 3**, Ladd further discloses:

Determining if the text indicating a programmed pause occurs within the audio text of the extracted audio segment (*identifying a break element, Col. 29, Line 58- Col. 30, Line 26*); and

Separating the audio text of the extracted audio segments into discrete audio text segments if the programmed pause occurs within the audio text of the extracted audio segment (*break element is inserted between two segments of audio text, Col. 29, Line 58- Col. 30, Line 26*).

With respect to **Claim 4**, Busayapongchai does not specifically identify and create elements for variable text, however, Ladd further discloses:

Identifying text indicating a variable in the extracted audio segments (*“option” element in VoiceXML that defines multiple variable prompts, Col. 27, Line 53- Col. 29, Line 35*);

Determining if the variable has an associated text file containing variable values (*“option” element contains multiple segments of audio text, Col. 29, Lines 5-35*);

Creating a variable audio segment for each said variable value, if the variable has an associated text file (*audio prompt that is provided for each variable instance in the “option” element, Col. 29, Lines 5-35*); and

Modifying the audio segment containing the text indicating the variable (*“option” element is divided using separate script tags for each variable, Col. 29, Lines 5-35*).

With respect to **Claim 5**, Ladd further discloses:

Determining if the variable occurs within audio text of the audio segment (*identifying an “option” element, Col. 27, Line 53- Col. 29, Line 53*); and

Separating the audio text of the extracted audio segments into discrete audio text segments if the variable occurs within the audio text of the extracted audio segment (*separating opening prompts and variable elements, which are identified using tags, within an “option” element, Col. 29, Lines 5-35*).

Claims 12-15 contain subject matter respectively similar to Claims 2-5, and thus, are rejected under similar rationale.

Claims 22-25 contain subject matter respectively similar to Claims 2-5, and thus, are rejected under similar rationale.

13. **Claims 6-8, 16-18, and 26-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over Busayapongchai et al in view of Wen et al (*U.S. Patent: 6,341,959*).

With respect to **Claim 6**, Busayapongchai discloses the method for extracting and producing audio text for recording as applied to Claim 1. Busayapongchai also recites VoiceXML script comprising multiple sentences (*Paragraphs 0002-0003; and 0029*). Busayapongchai does not specifically suggest modifying multiple text segments to obtain only a single text segment if extracted audio segments contain more than one sentence, however, Wen recites the ability to detect and delete a repeated sentence, thus obtaining a single instance of that sentence (*Col. 3, Lines 64-65*).

Busayapongchai and Wen are analogous art because they are from a similar field of endeavor in language user interfaces. Thus, it would have been obvious to a person of ordinary skill in the art, at the time of invention, to modify the teachings of Busayapongchai with the repeated sentence detection means taught by Wen in order to save storage space in the VoiceXML system taught by Busayapongchai (*Wen, Col. 3, Lines 64-65*).

With respect to **Claim 7**, Busayapongchai further discloses:

Processing the extracted audio segments further includes sorting the extracted audio segments (*ordering text sequences for recording, Paragraph 0032*).

With respect to **Claim 8**, Busayapongchai discloses the identification of audio text as applied to claim 1, while Wen recites the ability to detect and delete repeated sentences, as applied to Claim 6.

Claims 16-18 contain subject matter respectively similar to Claims 6-8, and thus, are rejected under similar rationale.

Claims 26-28 contain subject matter respectively similar to Claims 6-8, and thus, are rejected under similar rationale.

14. **Claims 9, 19, and 29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Busayapongchai et al in view of Ladd et al, and further in view of Heinze et al (*U.S. Patent: 6,915,254*).

With respect to **Claim 9**, Busayapongchai in view of Ladd discloses the method for extracting and producing audio text having “option” elements for recording as applied to Claim 4. Ladd further recites that the variables within the option elements are nouns or open class words (*Col. 29, Lines 5-35*). Busayapongchai in view of Ladd does not specifically teach performing text parsing by dividing text at a closed class word, wherein a first audio text ends with a non-closed class word preceding the variable. Such a parsing principle, however, is well known in text processing, as is evidenced by Heinze. Heinze discloses breaking text at closed class words (*i.e., articles, prepositions, pronouns, etc.*) (*Col. 11, Lines 45-47; and Col. 19, Line 64- Col. 20, Line 12*). Thus, in the case of Heinze, the word preceding the closed-class word and ending the first segment would be non-closed class and would precede the variable, which are nouns (*i.e., open class words*) in the case of Ladd.

Busayapongchai, Ladd, and Heinze are analogous art because they are from a similar field of endeavor in text file processing systems. Thus, it would have been obvious to a person of ordinary skill in the art, at the time of invention, to modify the teachings of Busayapongchai in

view of Ladd with the parsing scheme taught by Heinze in order to provide natural language structure understanding in a script (*Heinze, Col. 4, Lines 33-37*).

Claim 19 contains subject matter similar to Claim 9, and thus, is rejected under similar rationale.

Claim 29 contains subject matter similar to Claim 9, and thus, is rejected under similar rationale.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: See PTO-892.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. Wozniak whose telephone number is (571) 272-7632. The examiner can normally be reached on M-Th, 7:30-5:00, F, 7:30-4, Off Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Edouard can be reached at (571) 272-7603. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/James S. Wozniak/
Primary Examiner, Art Unit 2626